

REMARKS

I. Status of the Claims

Claims 1-33, 38-82, and 87-102 are pending in this application.

Claims 1, 19, 26-29, 50, 68, 75-78, 98, and 102 have been amended such that “silicone derivative (b)” is now referred to as “silicone compound (b).” Support for this amendment can be found in the instant specification, and in the general knowledge in the art for the meaning of the term “derivative.” Accordingly, no new matter has been added by this amendment.

Applicant thanks Examiners Wells and Padmanabhan for the courtesies extended to Applicant’s representative during the interview of November 7, 2003, at which time this and related pending applications were discussed. The following responsive remarks address the substance of the interview.

II. Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejects claims 1-33, 38-32, and 37-102¹ under 35 U.S.C. § 112, second paragraph “for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.” Office Action at 2. Specifically, the Examiner states that “ ‘at least one silicone derivative (b)’ in claims 1, 50, and 102, and the phrase ‘at least one silicone derivative (b) is chosen from at least one derivative of

¹ While the Examiner said she was rejecting claims 1-33, 38-32, and 37-102 under 35 U.S.C. § 112, second paragraph in the October 23, 2003 Office Action, Applicant assumes she meant to

formula (I)[] in claims 19, 26, 68, and 75, is vague and indefinite." *Id.* Applicant continues to respectfully disagree with the Examiner for the reasons of record. However, per the discussion during the November 7, 2003 interview, and in the interest of advancing prosecution, Applicant has amended claims 1, 19, 26-29, 50, 68, 75-78, 98, and 102 to recite "silicone compound" rather than "silicone derivative." Thus, rendering this rejection moot. Applicant respectfully requests that the Examiner withdraw all rejections under 35 U.S.C. § 112, second paragraph.

III. Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-33, 38-82, and 87-102 under 35 U.S.C. § 103(a) as being unpatentable over Blankenburg et al. (WO 99/04750) ("Blankenburg") in view of Samain et al. (U.S. Patent No. 6,511,651) ("Samain"). See Office Action at 3.

The Examiner asserts that Blankenburg teaches "the use of polymers containing polysiloxanes for hair cosmetic formulations," and more specifically that "[a] water-dispersible polymer comprising ethylenically unsaturated monomers and polyalkylene oxide containing silicone derivatives." Office Action at 3. According to the Examiner, Blankenburg is deficient only in that it "lacks polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers, preferred cosmetic mediums, and preferred percent weight." *Id.*

The Examiner then cites Samain as teaching "an aerosol device comprising a container containing an aerosol composition, comprising a liquid phase containing a

indicate that she was rejecting claims 1-33, 38-82, and 87-102. Clarification is respectfully requested.

fixing material in a solvent and a propellant," where the "fixing materials are taught as polymers containing vinyllactam units, wherein polyvinylepyrrolidone/vinyl acetate/vinyl propionate terpolymers . . . as preferred polymers." Id. at 4. The Examiner then concludes that it "would have been obvious to one of ordinary skill in the art at the time the invention was made to add polyvinylepyrrolidone/vinyl acetate/vinyl propionate terpolymers as taught by Samain et al. to the hair fixative composition of Blackenburg . . ." *Id.*

Applicant respectfully traverses the Examiner's 103(a) rejection for at least the reason that the Examiner has failed to make a prima facie showing of obviousness. In order to establish a prima facie case of obviousness, the Examiner must, among other things, establish that the cited references contain all of the elements of the instant rejected claims, and point to a suggestion or motivation within the references to modify or to combine reference teachings. M.P.E.P. § 2143.

The present invention is directed to a composition comprising at least one silicone/acrylate copolymer; and **at least one nonionic polymer comprising at least one vinyllactam unit** chosen from polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers. Applicant respectfully points out that the Examiner's statement that Blankenburg "lacks polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers," overlooks the fact that the present invention claims at least one **nonionic polymer comprising at least one vinyllactam unit** chosen from polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers. The teachings of Samain, which the Examiner relies on to remedy the deficiencies of Blankenburg, do not include the claimed element of a nonionic polymer comprising at least one vinyllactam unit chosen from

polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers. Thus, the Examiner's rejection is deficient at least in that the cited references do not contain all claimed elements of the present invention.

Moreover, the Examiner has not shown any proof of motivation for the combination of the cited references. The Examiner attempts to support the allegation of obviousness on the following motivation argument:

- . . . a) Blackenburg [sic] and Samain et al. both teach hair care fixative compositions in the form of sprays;
- b) Samain et al. teach polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers as rigid enough to ensure that the hair is held in place and fragile enough for the user to be able to destroy the welds by combing or brushing the hair, without damaging the scalp or hair;
- c) Blackenburg [sic] teaches that vinylactam homo and copolymers are known in the art as synthetic polymers that have been used for almost 50 years to strengthen hairdos;
- d) Blackenburg [sic] teaches that other cosmetic agents can be added to his composition . . .

Id. at 4-5. Not one of points a) through d) demonstrates a motivation to modify the cited references. First, the fact that Blankenburg and Samain are both directed to fixative hair compositions does not provide a motivation for modification. It is not enough that references can be combined or modified -- this "does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed Cir. 1990)). The Examiner's conclusion that, because both references contain certain ingredients, one of ordinary skill in the art would be motivated to combine them, simply does not meet with this high threshold. Similarly, point b), the teaching of Samain as defined by

the Examiner, does not show any suggestion within Samain to modify the disclosure in a manner to arrive at the presently claimed invention. Rather, relying on such statements is tantamount to an improper obvious to try rejection. It is well-established law that the motivation to modify the prior art must flow from some teaching in the art that suggests ***the desirability or incentive to make the modification*** needed to arrive at the claimed invention. See M.P.E.P. § 2143.01; see, e.g., *In re Napier*, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). In order to support a rejection under 35 U.S.C. § 103, therefore, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner has not shown that either Blankenburg or Samain suggest the desirability of making the modifications necessary to achieve the presently claimed invention.

Further, in point c), the Examiner mischaracterizes the teaching of Blankenburg with respect to vinyllactams. Applicant respectfully submits that Blankenburg actually teaches away from the present claims. In its discussion of the use of synthetic polymers for hairstyling, for example, Blankenburg states that "[a]t first, vinyl lactam homopolymers and copolymers were preferred, ***but subsequently polymers containing carboxylate groups have become increasingly important.***" Blankenburg translation at page 1 (emphasis added). With such a statement at the very beginning of Blankenburg's disclosure, there is no rational reason the Examiner can assert that any person of ordinary skill in the art would be motivated to subsequently combine any teaching of Blankenburg with a nonionic polymer comprising at least one vinyllactam.

Finally, the fact that Blankenburg may teach that other cosmetic agents can be added to the composition, point d), does not constitute a suggestion to modify Blankenburg with the addition of vinylactams.

Indeed, absent an improper reliance on Applicant's disclosure, it is not clear how one skilled in the art would expect to achieve beneficial properties associated with the combination of claimed components considering that there is no teaching in either reference disclosing compatibility of the two compositions. That is, not only is there no suggestion to combine the two references, there is no expectation that either disclosed composition would work for its intended purpose once combined with the other.

Thus, for at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to make a prima facie showing of obviousness, and requests the withdrawal of all rejections.

CONCLUSION

In view of the foregoing amendment and remarks, Applicant requests reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 22, 2004

By: Deborah M. Sharfman
Deborah M. Sharfman
Reg. No. 52,211